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Hearing:
20 APR 2004

Mailed:
June 22, 2004
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tundra Trading, Inc.

Serial Nos. 76409942 and 76409943

Hae Park-Suk of Law Offices of J. Michael Cleary, P.C. for
Tundra Trading, Inc.

Brendan D. McCauley, Trademark Examining Attorney, Law
Office 114 (K. Margaret Le, Managing Attorney).

Before Hairston, Rogers, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 24, 2002, Tundra Trading, Inc. (applicant)
applied to register on the Principal Register the marks
TUBI'S TIRE TREAD LICORICE (typed) and with the design
shown below for "licorice" in International Class 30.



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Both applications (Serial Nos. 76409942 and 76409943) are based on a claim of first use of March 1, 2002, and a date of first use in commerce of April 9, 2002. Both applications were amended to claim ownership of Registration No. 2,459,679 for the mark TUBI'S. Applicant has also offered to disclaim the term "licorice."

The examining attorney has refused to register applicant's marks without a disclaimer of the additional term "tire tread" under the provision of Section 6(a) of the Trademark Act. 15 U.S.C. § 1056(a). The examining attorney has required a disclaimer of the term because he found that the term merely described, under 15 U.S.C. § 1052(e)(1), a characteristic or feature of applicant's goods, "namely, the licorice is in the shape of a tire tread." Examining Attorney's Brief at 5. After the examining attorney made the requirements for the broader disclaimer final, applicant subsequently filed these appeals.¹

We reverse.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information

¹ On October 27, 2003, the board granted applicant's motion to consolidate these appeals.

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regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("A mark is merely descriptive if it immediately conveys qualities or characteristics of the goods"). In descriptiveness cases, we look at the mark in relation to the goods or services, and not in the abstract. Abcor, 200 USPQ at 218. However, in order for a term to be merely descriptive, it must describe, at least, "a single, significant quality, feature, function, etc." of the services. In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985) (emphasis added). See also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987).

In this case, we begin with the examining attorney's evidence that supports his position that the term "tire tread" is merely descriptive of a type of licorice. The examining attorney has included a definition of the term "tread" meaning "the part of a wheel or tire that makes contact with the road or rails" and the "grooved face of a tire." Other evidence includes a description of applicant's goods on the www.candyusa.org website as follows: "Tire Tread Black Licorice - Licorice lovers will enjoy new Tire Tread Licorice, a velvety-smooth, not-to[o]-

sweet chewy black licorice that resembles pieces of tire treads." The examining attorney also included numerous excerpts that suggest that candy and licorice often come in a variety of shapes that are either described or suggested by their names. The following examples are from the same site: "Juicee Gummee Strawberry Dreams and Frogees - These chewy candies add a new measure of pleasure to gummy candies. They come in strawberry and frog shapes made with real fruit juice"; "Scripture Candy - These sugar-free breath mints are shaped like tiny fish symbols and are packaged in attractive tins that feature inspirational verses printed on the inside of the lids"; and "Butt-Ugly Martian Candy and Bubble Gum - Based on the hot new kids' character... The gum comes in martian shapes."

Applicant responds by arguing that:

Consumers clearly are capable of associating such marks with a single source, as in the case of the ubiquitous "Goldfish" goldfish-shaped crackers, along with the "Teddy Grahams" teddy bear shaped crackers, "Robin Eggs" egg-shaped chocolate candy, "Stinky Feet" feet-shaped candy and cookies, "Heavenly Hearts" heart-shaped candy and chocolate, "Paw Print" paw-shaped candy and bubble gum, as well as numerous other examples cited in Applicant's Requests for Reconsideration.

All of these products are identified by terms which fall similarly, or even closer to the descriptive end, on the descriptive/suggestive sliding scale as the terms in the instant case... Applicant respectfully emphasizes that each of these marks have been

registered on the Principal Register *without* a disclaimer of the relevant term.

Applicant's Brief at 7 (emphasis in original).

Applicant submitted copies of the pertinent registrations with evidence that the mark was used on items that resembled the terms in the trademark registrations.² Applicant also cites the case of RFE Industries Inc. v. SPM Corp., 105 F.3d 923, 41 USPQ2d 1626, 1629 (4th Cir. 1997) for the proposition that an "important distinction must be made when the product only resembles, and does not replicate, the shape."

The examining attorney argues that "tire tread licorice" indicates "a characteristic or feature of the goods, namely, that the licorice is in the shape of a tire tread." Examining Attorney's Brief at 5. While the difference between a term that is suggestive as opposed to descriptive is often somewhat nebulous, in this case, we are not persuaded by the examining attorney's arguments. One of our principal disagreements with the examining attorney concerns his key point that applicant's licorice is in the shape of a tire tread. The packaging for

² See, e.g., Reg. No. 1,798,043 (ROBIN EGGS); No. 1,511,957 (PAW PRINT); and No. 1,474,372 (GRAHAMY BEARS). Applicant also included the entire file for Reg. No. 739,118 for the mark GOLDFISH.

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applicant's goods includes the design mark in the '943 application, which appears to feature the design of a tire tread. The actual goods in the packaging in the record do not resemble that design and the examining attorney has not included evidence that applicant's actual goods are a recognized tire tread design. Moreover, the examining attorney has not required a disclaimer of what appears to be the design of the tire tread in the '943 application. Here, the design of applicant's goods resembles a grooved pattern where the grooves are simply shown in a straight-line pattern. We have no doubt that applicant's actual licorice pieces may suggest or call to mind a tire tread if one studies the goods along with the term, but it is not at all clear that consumers would immediately understand that applicant's term is simply describing its goods. When we analyze whether a term is descriptive, we must view the term in relation to the goods and not in the abstract. When prospective purchasers are confronted with the mark and the actual goods in the record, it is likely that these purchasers would use some imagination to reach the conclusion that applicant's goods are supposed to resemble tire tread patterns. The relevant case law concerning the distinction between descriptive and suggestive terms emphasizes the importance of the immediateness of the

information conveyed to prospective purchasers. In re Recovery, Inc., 196 USPQ 830, 832 (TTAB 1977) (A term is not merely descriptive if one "must engage in a mental process involving imagination, speculation, and possibly stretching the meaning of the word to fit the situation").

In this case, while the examining attorney has shown that candy and licorice are sometimes produced in the shape of animals and even smoking pipes, it is much less clear that the public would immediately associate candy shapes with automobile parts. Furthermore, "tread" is a more nebulous term inasmuch as it refers to the pattern of a tire. In this case, purchasers would have to study the term TUBI'S TIRE TREAD LICORICE and the goods. In effect, the term "tire tread" does not simply describe the goods, it provides an interpretation of what applicant intends the goods to resemble. Without the term "tire tread," it is quite possible that consumers would not even understand that applicant's goods are supposed to resemble chunks of tire treads. By using the term tire tread as a guide, these consumers may conclude that applicant's goods are a tire tread design. However, this lack of immediate recognition and resulting thought process removes applicant's term from the merely descriptive category and

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leads us to conclude that the refusals to register are not appropriate.

Decision: The refusals to register applicant's marks without a disclaimer of the term "Tire Tread" are reversed.